

**REMARKS:**

Claims 1-43 are currently pending in the application.

Claims 11-26, 37-40 and 42 are withdrawn from consideration.

Claims 1-10, 27-36, 41, and 43 stand rejected under 35 U.S.C. § 112.

The Applicant respectfully submits that all of the Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections. In addition, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

**REJECTION UNDER 35 U.S.C. § 112:**

Claims 1-10, 27-36, 41, and 43 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Applicant respectfully disagrees.

Nonetheless, the Applicant has amended independent Claims 1, 27, 41, and 43 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action.

For example, the Applicant respectfully directs the Examiner's attention to MPEP 2163 which provides guidelines for determining whether claims comply with the written description requirement of 35 U.S.C. § 112, first paragraph. In particular, MPEP 2163(III)(A) provides that ***the Examiner bears the initial burden*** of establishing that claims fail to comply with the written description requirement:

A description as filed is ***presumed to be adequate***, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. ***The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.*** *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. (Emphasis added).

Thus, failure to comply with the written description requirement ***must first be established by the Examiner***, and the showing must be made ***by a preponderance of the evidence***. MPEP 2163(III)(A) then explains that ***a proper showing must include express findings of fact*** that establish reasons why one skilled in the art would not have recognized that the inventor possessed the claimed invention:

In rejecting a claim, the examiner must set forth ***express findings of fact*** regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) ***Identify the claim limitation at issue***; and

(B) ***Establish a prima facie case*** by providing ***reasons why a person skilled in the art at the time the application was filed would not have recognized*** that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. ***A general allegation of "unpredictability in the art" is not a sufficient*** reason to support a rejection for lack of adequate written description. (Emphasis added).

It should also be noted that the standard for compliance with the written description requirement involves the person of ordinary skill in the art, and what such a person would understand based on the written description:

The fundamental factual inquiry is whether the specification conveys with reasonable clarity **to those skilled in the art** that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. MPEP 2163 (emphasis added).

As pointed out in MPEP 2163, “there is no *in haec verba* requirement.”

Thus, ***the Examiner bears the initial burden of establishing a prima facie case of failure to comply with the written description requirement***, and in order to do so the Examiner must establish, ***by a preponderance of the evidence***, reasons why one of ordinary skill in the art would not have recognized from the written description that the inventor was in possession of the claimed invention at the time the application was filed.

#### **The Office Action has Failed to Properly Establish a *Prima Facie* case of Failure to Comply with the Written Description Requirement**

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of failure to comply with the written description requirement. ***The Office Action has not shown by a preponderance of evidence***, let alone any evidence, why a person skilled in the art would not recognize the description of the invention as defined by the claims, of the subject Application. The Office Action merely states that these “claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that ***to duplicate this invention without trial and error.***” (1 June 2007 Final Office Action, Page 5). (Emphasis Added). The Applicant respectfully disagrees.

The Applicant respectfully submits that the Examiner has mischaracterized the determination of whether claims comply with the written description requirement of 35 U.S.C. § 112, first paragraph. For example, the Applicant directs the Examiner's attention to 35 U.S.C. § 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms ***as to enable any person skilled in the art to***

***which it pertains***, or with which it is most nearly connected, ***to make and use the same***, and shall set forth the best mode contemplated by the inventor of carrying out his invention. (Emphasis Added).

***The Applicant respectfully requests the Examiner to cite a specific rule in 37 C.F.R. or in the MPEP that specifically states*** that a claim must “contain subject matter” that is described in the specification “to reasonably convey to one skilled in the relevant art that ***to duplicate this invention without trial and error.***”

Furthermore, the Examiner asserts that “Claims 1-10, 27-36, 41, and 43 are rejected under 35 U.S.C. § 112, first paragraph, because: they are essentially directed to a software imbedded [sic] in a computer-readable media and using in a system – even pending claims are directed to ‘system’ because incorporating that specific software (a MUST) can be considered as a brain of this invention (while the submitted specification provides nothing to enable one with ordinary skill in the art to practice – non enablement); and the specification does not reasonably provide enablement of a claimed software for use in a claimed system.” (1 June 2007 Final Office Action, Pages 5-6). (Emphasis Original). The Applicant respectfully disagrees and further respectfully request clarification as to what the Examiner is referring to or even how this relates to the subject Application.

The Applicant respectfully submits that ***the Examiner has failed to provide a proper showing of any express findings of fact which supports the alleged lack of written description.*** The Examiner further asserts that the “[A]pplicant only provides a very high level drawing (i.e. Fig. 5), not the essential codes and instructions – the subject matter of this invention – to make this invention.” (1 June 2007 Final Office Action, Page 6). (Emphasis Added). The Applicant respectfully disagrees and further ***respectfully requests the Examiner to cite a specific rule in 37 C.F.R. or in the MPEP that specifically requires*** the Applicant to provide “essential codes and instructions” in order to comply with the written description requirements of 35 U.S.C. § 112, first paragraph.

***The Applicant respectfully submits that the Examiner’s initial burden of presenting by a preponderance of evidence has not been met in the Office Action***

**mailed on 1 June 2007.** The Applicant further respectfully submits that the Examiner's conclusory statements in the present Office Action are merely a general allegation and are not a sufficient reason to support a rejection for lack of adequate written description. In addition, ***since the Office Action fails to provide any of the requisite analysis for supporting this rejection, it is respectfully submitted that the rejection is improper and should be withdrawn.*** The Examiner may call the undersigned, Steven J. Laureanti, at (480) 830-2700 if the Examiner believes that it would be easier to discuss the 35 U.S.C. § 112 rejection over the phone.

In addition, the Examiner specifically asserts that the "disclosure does not provide sufficient details: how is it ("pointer") made? What is that claimed "pointer"?". (1 June 2007 Final Office Action, Page 4). The Examiner further asserts that "Claims 1-10, 27-36, 41 and 43 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement [...] ***These claims contain subject matter which was not described in the specification in such way as to reasonably convey to one skilled in the relevant art that to duplicate this invention without trial and error*** [...] and] the specification does not reasonably provide enablement of a claimed software for use in a claimed system." (Emphasis Added). (1 June 2007 Final Office Action, Page 5).

However, the Applicant respectfully submits that the Examiner has already admitted on the record that:

An arguable (core) limitation of the invention's subject matter is using a pointer to [sic] accessing a seller's database; ***this was already known*** (see Barry et al, US Pat 6,615,258, claims 25 or 57; or Tenorio et al, US Pat 6,708,161 – col. 6 lines 8-25, 57-64, or col. 9 lines 35-42. (19 October 2005 Office Action, Page 5).

Therefore, the Applicant respectfully submits that the Applicant is confused as to how the Examiner, now, finds a specific lack of enablement of the "pointer" limitation when on 10 October 2005 (and admittedly within the context of an obviousness determination), the Examiner found that such a limitation "was already known".

Moreover, the meaning of the term “pointer” within the computer context is easily and readily discernable by those with common knowledge within the art. For example, the Examiner’s reliance upon “geek.com” clearly shows that the term “pointer” has a clear, readily discernable and unmistakable meaning that would be readily appreciated by those with skill in the art. Ultimately, the fact that the term “pointer” is well known (as admitted by the Examiner in playing a key role in an obviousness determination) and is so readily capable of definition clearly demonstrates that the description contained within the original specification is sufficient to reasonably convey to one skilled in the relevant art that enough information to duplicate this invention without [undue] trial and error.

**The Applicant’s Claims are in Full Compliance with the Requirements of 35 U.S.C. § 112, First Paragraph**

The Applicant respectfully submits that independent Claims 1, 27, 41, and 43 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicant further respectfully submits that independent Claims 1, 27, 41, and 43 are in condition for allowance. In addition, Claims 2-10 and 28-36 depend from independent Claims 1, and 27, respectively. Thus, dependent Claims 2-10 and 28-36 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, the Applicant respectfully requests that the rejection of Claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 112 be reconsidered and that Claims 1-10, 27-36, 41, and 43 be allowed.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$790.00 RCE fee, to Deposit Account No. 500777.** Although the Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

28 August 2007  
Date

/Steven J. Laureanti/signed  
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**CUSTOMER NO. 53184**